### ARGUMENT AND REMARKS

In an *Advisory Action* dated August 24, the Examiner withdrew his previous indications as to the allowability of the present application. The Examiner reintroduced rejections under 35 U.S.C. § 112 pertaining to (1) incorporation by reference, (2) introduction of new matter through the terminology "coupling" and (3) enablement of the claimed invention. The Examiner also reintroduced an obviousness rejection under 35 U.S.C. § 103 as to, at least, presently pending claim 32.

Claims 24-26 remain pending and present for examination as do claims 32-35, 41-45 and claims 46-52.

## 35 U.S.C. § 112, ¶ 1: Incorporation by Reference

The Examiner, in his *Advisory Action* dated August 24, re-introduced his previously withdrawn assertion that an applicant "cannot incorporate by reference to various US patents **essential subject matter** as applicant is believed to have done." Page 2, ¶ 2 (emphasis added). Applicant, again, respectfully traverses the Examiner's contention.

The Manual of Patent Examining Procedure (the "MPEP")—in reference to Exparte Schwarze, 151 USPQ 426 (Bd. App. 1966)—explicitly notes that "[m]aterial... may be incorporated by reference" in a patent application. MPEP § 608.01(p)(I)(A). The MPEP, in fact, notes that "[a]n application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application." MPEP § 608.01(p)(I)(A) (emphasis added). Furthermore, if an incorporation by reference is made to a pending application, an applicant "will be required to amend the disclosure of the referencing application to include the material incorporated by reference." MPEP § 608.01(p)(I)(A)(1) (emphasis added).

These requirements set forth by the MPEP clearly refute the Examiner's argument that (1) incorporation by reference as to essential material is improper and (2)

amendment of the specification to explicitly include that referenced material is improper. The *only* caveat as to such an amendment of the specification is that such an amendment may be required to be "accompanied by an affidavit or declaration executed by . . . a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by reference in the referencing application[s]." MPEP § 608.01(p)(I)(A)(1). Accompanying the present request for continued examination is a declaration, executed by a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by reference in the referencing applications (Appendix A).

## 35 U.S.C. § 112, ¶ 1: Coupling

The Examiner, in his *Advisory Action* dated August 24, re-introduced his previously withdrawn rejection concerning "coupling" as being representative of the introduction of new matter. In particular, the Examiner stated he "has never seen this term used as being synonymous with adhesive bonding or the like." Page 2, ¶ 2. Applicant, again, respectfully traverses the Examiner's contention.

Applicant refers the Examiner to Stephen Key Design, L.L.C. v. Lego Systems, Inc., 261 F. Supp.2d 1196 (N.D. Cal. 2003). A copy of this decision is enclosed for the Examiner's ease of reference (Appendix B). The plaintiff in the Stephen Key Design action is the same applicant-assignee for the present application—Stephen Key Design, L.L.C. Accompanying the present request for continued examination is a copy of the assignment reflecting Stephen Key Design, L.L.C. as the owner of the entire right, title and interest in this application (Appendix C). The inventor for the present application—Stephen M. Key—was also the inventor for the patents at issue in the aforementioned Stephen Key Design action. As such, the Examiner is respectfully requested to give earnest consideration as to the inventor's use of certain terms—such as "coupling"—the inventor being one skilled in the art.

In the <u>Stephen Key Design</u> action, the court construed a number of terms from U.S. patent number 6,086,697 ("the '697 patent") and U.S. patent number 6,237,269 ("the

'269 patent"). The Examiner is respectfully requested to take notice of the fact that the present application is a divisional application of U.S. patent number 6,402,872 which is, in turn, a continuation-in-part of the '697 patent construed in the aforementioned <a href="Stephen Key Design">Stephen Key Design</a> action. As such, the court's construction of certain terms in that action is *extremely relevant* to the present application. The court, in the <a href="Stephen Key Design">Stephen Key Design</a> action, construed "coupling" to mean "to fasten together." <a href="Stephen Key Design">Stephen Key Design</a>, 261 F. Supp.2d at 1201 (emphasis added). Similarly, the court found "uncoupling" to mean "[t]o detach, disjoin or disconnect." <a href="Id">Id</a>. at 1202. The court's construction of "coupling" is, as shown, consistent with that definition presently advanced by the Applicant in the present application but rejected by the Examiner as not "being synonymous with adhesive bonding or the like." <a href="Advisory Action">Advisory Action</a>, Page 2, ¶ 2.

Applicant also respectfully addresses the Examiner's attention to Applicant's After Final Amendment filed July 1, 2004 wherein it was noted that "coupling" is well known in the art to be construed as "means for joining two parts." Winther v. Winslow 120 USPQ 452, 454 (P.O. Bd. Int. Exrs. 1958). This definition, too, is consistent with the court's construction and the meaning advanced by the Applicant.

Applicant also respectfully addresses the Examiner's attention to U.S. patent number 6,649,007 for a *Rotatable Label for Pharmaceutical Container and Method for Constructing Same*. This patent has the same inventor and assignee as the present application. In this patent, Figure 7a depicts an inner label portion *coupled* to an outer label portion thereby enabling a label to be applied to a pharmaceutical container in a single step. Figure 9a of this patent also depicts a label wherein an outer label portion is adapted with upper and lower rails, the rails being *coupled* to the outer label portion by horizontal perforation lines.

Applicant also respectfully addresses the Examiner's attention to U.S. patent number 6,631,578 for a *Roll-Fed Method for Constructing a Rotatable Label System*. This patent has the same inventor and assignee as the present application. In this patent, claim 11 evidences a rotatable outer label being temporarily *coupled* to an inner label.

Similarly, claim 24 evidences a leading edge.of a rotatable label being temporarily *coupled* to an inner label disposed about an object.

Applicant also respectfully addresses the Examiner's attention to U.S. patent number 6,086,697 for a *Rotating Label System and Method*. This patent has the same inventor and assignee as the present application in addition to expressly being incorporated by reference. This patent evidences the removable *coupling* of an outer label to a container. Figure 5 of this patent illustrates the label being *coupled* to the container; specifically, "the adhesive rear surface 126 of the release tab 106 is then *adhered* to the inner label front surface 172 to *couple* the outer label to the container 140 via the inner label 170." Col. 5, I. 15-17 (emphasis added).

Finally, the Applicant respectfully addresses the Examiner's attention to U.S. patent number 5,884,421 for an *Apparatus and Method for Constructing a Rotatable Label Device*. This patent has the same inventor and assignee as the present application in addition to expressly being incorporated by reference. This patent evidences an inner shell being securely *coupled* to a container by an *adhesive* substance in Figure 20.

Based on the aforementioned district court decision and myriad patents evidencing the use of the term *coupled*, Applicant, again, respectfully suggests it is not necessary to rehash skills or processes that, in the relevant field, are already well known. See Webster Loom Co. v. Higgins, 105 U.S. 580 (1882). As such, "[t]hat which is common and well known is as if it were written out in the patent and delineated in the drawings." *Id.* at 586. As such, Applicant contends its amendments as to "coupling" cannot be construed as new matter.

### 35 U.S.C. § 112, ¶ 1: Enablement

The Examiner, in his *Advisory Action* dated August 24, re-introduced his previously withdrawn assertion that the Applicant's specification "is seen to be little more than an invitation to experiment with respect to such elements as permanent or temporary adhesive, and also its characterization of 'water', 'static electricity', and

'application of pressure' as apparently some sort of temporary adhesive." Page 2-3,  $\P$  3. Applicant, again, respectfully traverses the Examiner's contentions.

The Examiner's rejection is, initially, believed to be partially-moot as nowhere in the amended claims does there exist the terminology "temporary adhesive" or "permanent adhesive." The rejection should, in this regard, be withdrawn.

As to the invitation to experiment, the Northern District of California found otherwise as the court's *Stephen Key Design* decision recognized that the presently incorporated '269 patent teaches "several methods of temporarily coupling": a blast of air or other gas, moisture, holding or pressing, vacuum pressure or static electricity. Stephen Key Design, 261 F. Supp.2d 1201; see also In re Vaeck, 947 F.2d 488, 495 (Fed. Cir. 1991) ("[E]nablement is a question of law based on underlying factual findings") (emphasis added). 35 U.S.C § 112, ¶ 1 "requires nothing more than objective enablement. How such a teaching is set forth, either by broad use of illustrative examples or by broad terminology, is of no importance." In re Marzocchi 439 F.2d 220, 223, 169 USPQ 367 (C.C.P.A. 1971) (emphasis added). Applicant believes it has, at least, provided a broad illustrative example.

Further, the Applicant respectfully reminds the Examiner it is "a matter of Patent Office practice" that:

a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support

<u>Id.</u> (emphasis added).

Applicant respectfully contends the Examiner has no reason to doubt this objective truth. "As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied." MPEP §

2164.01(b) (emphasis added); <u>In re Fisher</u>, 427 F2d 833, 839 (CCPA 1970). Applicant contends such a reasonable correlation exists.

Furthermore, in order to sustain an enablement rejection, "the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." MPEP § 2164.04 (emphasis added); In re Wright, 999 F.2d 1557, 1562 (Fed. Cir. 1993). "[I]t is incumbent upon the Patent Office, whenever a rejection [of enablement] is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." In re Marzocchi, 439 F.2d 220, 224 (CCPA 1971) (bold emphasis added). Applicant, in addition to contesting the legal impropriety of such a rejection, also contends the Examiner has procedurally failed to provide sufficient evidence to support such an enablement rejection. The Examiner "should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation." MPEP § 2164.04. The Examiner must supply specific technical reasons as such reasons "are always required." Id. (emphasis added). And finally, it is noted that "[t]he examiner should never make [this] determination based on personal opinion." MPEP § 2164.05 (emphasis in the original); contra Advisory Action, Page 2-3, ¶ 3 ("it is believed that applicant's specification is seen to be little more than an invitation to experiment").

### 35 U.S.C. § 103: Barnum, Jr.

The Examiner, in his *Advisory Action* dated August 24, re-introduced his previously withdrawn rejection of the non-obviousness of the application as to, *inter alia*, *Barnum*, *Jr*. Applicant, again, respectfully traverses.

Applicant respectfully reminds the Examiner that *Barnum*, *Jr.*—by itself—does not provide a proper basis for a 35 U.S.C. § 103 rejection in that *Barnum*, *Jr.* does not teach the temporary coupling of an outer label to an inner label and subsequently removing the coupling to permit the outer label to rotate about the inner label as is

required by the relevant claims of the Applicant's invention. Combining *Barnum*, *Jr*. with previously cited *Ingle*, *Fumei* or *Haines* does nothing more than add the teaching of a bonding agent; the combination **still fails to teach temporary coupling and subsequent removal** of the coupling to provide for rotation of the outer label.

Applicant, therefore, sustains his traversal that (1) such a combination fails to teach Applicant's claimed invention and (2) that it remains necessary to ascertain whether or not the reference teachings appear to be sufficient for one of ordinary skill in the relevant art, having the reference before him, to make the proposed combination.

See In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560 (CCPA 1972). As to the second matter, Applicant maintains his contention there is no suggestion to combine the freely rotating sleeve of *Barnum*, *Jr*. with the affixing agents of *Ingle*, *Fumei* and *Haines*. The Examiner, previously, provided no basis for the proposed combination beyond a mere "belie[f] one of ordinary skill in the art" would make such a combination. The Examiner, in his present *Advisory Action*, asserts only that "one of ordinary skill would not be restricted to looking only at presently existing rotatable labels." Page 3, ¶ 4. The Examiner's current statements still fail to satisfy the burden concerning motivation as the Examiner provides no basis for *why* the proposed combination would be made, notwithstanding the fact that such an unmotivated combination would ultimately fail to produce the Applicant's claimed system.

The Examiner is respectfully reminded that one's belief, standing alone, hints of "hindsight analysis and rote application of the legal test for obviousness." In re Rouffet, 149 F.3d 1356, 1358, 47 U.S.P.Q.2d 1453 (Fed.Cir. 1998). Failure to "explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one . . . to make the combination" leads to an inference of selecting references "with the assistance of hindsight." Id. (emphasis added). The Federal Circuit has expressly forbidden "the use of hindsight in the selection of references that comprise the case of obviousness." Id. (citing In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885 (Fed.Cir. 1991)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art

suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed.Cir. 1992) (emphasis added). Applicant contends the lack of explanation as to a specific understanding of the motivation to combine, much less a suggestion as to the desirability of the combination of *Barnum*, *Jr*. with *Ingle*, *Fumei* and *Haines*, should result in the withdrawal of the Examiner's 35 U.S.C. § 103 rejection.

### **CONCLUSION**

Based on the foregoing remarks, Applicant believes that the objections and rejections in the Office Action are fully overcome and that the application is in condition for allowance. If the Examiner has any questions regarding the case, the Examiner is invited to contact Applicant's undersigned representative.

Respectfully submitted, Stephen M. Key

**September 24, 2004** 

By:

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### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:

Stephen M. Key

APPLICATION NO.:

10/005,428

FILING DATE:

December 3, 2001

TITLE:

**Rotating Label System** 

**EXAMINER:** 

Daniel R. Zirker

ART UNIT:

1771

CONF. NO.:

1741

ATTY.DKT.NO.:

**PA2321US** 

### DECLARATION OF PRACTITIONER REPRESENTING APPLICANT

I, Susan Yee, hereby declare that the facts set forth herein are within my personal knowledge, or appear from documents and information received by me in the course of this matter and, if called upon to do so, could and would testify to the truth thereof:

- 1. I am a registered patent attorney presently in good standing before the United States Patent and Trademark Office; my registration number is 41,388;
- 2. I presently represent the applicant for this matter, Stephen M. Key and the assignee, Stephen Key Design, LLC;
- 3. The amended material incorporated into the specification of this application in an amendment dated January 21, 2004 consists of and is fully supported by those patent and patent application references incorporated into the specification by reference.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

September 24, 2004

Susan Jee Susan Yee

### ASSIGNMENT

For good and valuable consideration, receipt of which I hereby acknowledge, I, Stephen M. Key, do hereby sell, assign and transfer unto Stephen Key Design, LLC, a California limited liability company, whose address is 10212 Whitetail Drive, Oakdale, California 95361 (called the Assignee herein), and its successors and assigns, the entire title, interest and right, including the right of priority, in, to and under an application for Letters Patent of the United States entitled "Rotating Label System and Method" executed by me this day, and the inventions and any of them therein set forth and described, and any and all Letters Patent of the United States and of countries foreign thereto which may be granted thereon or therefor or corresponding thereto;

And for the above consideration I agree promptly upon request of the Assignee, its heirs, successors or assigns, to communicate any facts known to me respecting said application and the invention set forth therein, and to execute and deliver without further compensation any power of attorney, assignment, application, whether original, continuation, divisional or reissue, or other papers which may be necessary or desirable fully to secure to the Assignee, its heirs, successors and assigns, the inventions and any of them described in said application and all patent rights therein, in the United States and in any country foreign thereto, and to cooperate and assist in the prosecution of interference proceedings involving said inventions and in the adjudication and re-examination of said Letters Patent, provided the expenses which may be incurred by me in lending such cooperation and assistance be paid by the Assignee.

IN WITNESS WHEREOF, I hereunto set my hand and seal this 10<sup>th</sup> day of April 2000.

Stephen M. Key

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## Motions, Pleadings and Filings

United States District Court, N.D. California.

STEPHEN KEY DESIGN, LLC, et al., Plaintiffs, v.
LEGO SYSTEMS, INC., et al., Defendants.

No. C 01-2607 MJJ.

May 6, 2003.

Owner of patents for making and attaching rotatable labels sued competitor for infringement. Construing claims, the District Court, Jenkins, J., held that "temporary coupling" of inner and outer labels meant fastening of labels together for limited time, and, upon uncoupling, allowing of outer label to rotate about inner label and/or labeled container.

Claims construed.

#### West Headnotes

# 11 Patents 314(5) 291k314(5) Most Cited Cases

Construction of patent claim language is matter of law for court.

[2] Patents 6 165(1) 291k165(1) Most Cited Cases

[2] Patents 167(1) 291k167(1) Most Cited Cases

121 Patents 168(2.1) Most Cited Cases

To determine meaning of patent claim, construing court considers three sources: claim itself, specification, and prosecution history.

131 Patents 161 291k161 Most Cited Cases There is heavy presumption that patent claim terms bear their ordinary meaning, as understood by persons skilled in relevant art.

## 162 Patents 62 291k162 Most Cited Cases

Presumption that patent claim term bears its ordinary meaning is only rebutted in situations where inventor: (1) acting as his own lexicographer, clearly sets forth explicit definition of term that is different from its ordinary meaning, or (2) has disavowed or disclaimed scope of coverage by using words of manifest exclusion or restriction.

## 151 Patents 168(2.1) 291k168(2.1) Most Cited Cases

Concession made or position taken to establish patentability in view of prior art, upon which examiner has relied, is substantive position which generally estops patentee from taking contrary position in infringement action; in contrast, when claim changes or arguments are made in order to impart precision, and not to overcome prior art, estoppel is not presumed.

## <u>[6]</u> Patents € 159 291k159 Most Cited Cases

Ordinarily, court should not rely on expert testimony to assist in patent claim construction.

## 17] Patents 159 291k159 Most Cited Cases

Extrinsic evidence should be used only if needed to assist in determining meaning or scope of technical terms in patent claims, and may not be used to vary or contradict terms of claims.

## [8] Patents 59 291k159 Most Cited Cases

Court construing patent is free to consult reference materials, such as dictionaries, for assistance in determining ordinary meaning of claim term; such sources are not considered extrinsic evidence. 261 F.Supp.2d 1196 261 F.Supp.2d 1196

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## 191 Patents 159 291k159 Most Cited Cases

If more than one dictionary definition is consistent with use of patent claim term in intrinsic record, term may be construed to encompass all such consistent meanings.

## 161 Patents 6 161 291k161 Most Cited Cases

Court construing patent has discretion to admit and rely upon prior art proffered by party, whether or not cited in specification or file history, but only when meaning of disputed term cannot be ascertained from careful reading of public record.

## 111 Patents 161 291k161 Most Cited Cases

# 111 Patents 168(2.1) Patents 168(2.1) Most Cited Cases

Subjective intent of inventor when he or she used particular patent claim term is of little or no probative weight in determining scope of claim, except as documented in prosecution history; rather, focus in claim construction is on objective test of what one of ordinary skill in art at time of invention would have understood term to mean.

# 101(2) Patents 101(2) 291k101(2) Most Cited Cases

Application of "external physical pressure," called for in patent for rotatable label system, meant application of force to labels and container by holding and pressing apparatus that arose or acted from outside; i.e., separately and independently from labels and container.

# 101(2) Patents 101(2) 291k101(2) Most Cited Cases

"Temporary coupling" of inner and outer labels, as called for in patents for rotatable label system, meant fastening of labels together for limited time, and, upon uncoupling, allowing of outer label to rotate about inner label or labeled container.

# 101(2) Patents 291k101(2) Most Cited Cases

"Temporary adhering" of inner and outer labels, as

called for in patent for rotatable label system, meant temporarily holding fast or sticking by or as if by gluing, suction, grasping, fusing, or otherwise.

# 101(2) Patents 0101(2) 291k101(2) Most Cited Cases

"Uncoupling" of leading end of outer label from inner label, as called for in patent for rotatable label system, meant detachment, disjoinder, or disconnection of temporary connection of outer label's leading end.

## Patents € 328(2) 291k328(2) Most Cited Cases

6,086,697, 6,237,269. Construed. \*1198 Jason T. Anderson, John S. Ferrell, Robert J. Yorio, Carr & Ferrell LLP, Palo Alto, CA, for Plaintiffs.

Frederick L. Whitmer, Gerald Levy, Pitney Hardin Kipp & Szuch LLP, Morristown, NJ, John P. Bovich, Reed Smith Crosby Heafey LLP, San Francisco, CA, for Defendants.

### **CLAIM CONSTRUCTION ORDER**

JENKINS, District Judge.

#### INTRODUCTION

This matter concerns the alleged infringement of: (1) U.S. Patent No. 6,086,697 (" '697 patent"), entitled "Rotating Label System and Method," and (2) U.S. Patent No. 6,237,269 (" '269 patent"), entitled "Roll-Fed Method for Constructing a Rotatable Label System." The Court will now construe the disputed claim terms within the two patents.

#### FACTUAL BACKGROUND

Stephen M. Key is the named inventor in each of the patents, both of which are assigned to Stephen Key Design, LLP. [FN1] The two patents generally disclose systems and methods for "constructing a rotatable label and attaching the rotatable label to a container." '697 Patent at Abstract; '269 Patent at Abstract.

FN1. The '269 and '697 patents are attached

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as Exhibits A and B to Plaintiffs' Supporting Evidence for Opening Claims Construction Brief ("Plaintiff's Supporting Evidence").

More specifically, the rotatable label described in the '697 patent "includes a release tab releasably attached to the container, or to an inner label adhered to the container, to secure the outer label to the container while the outer label is wrapped around the container." '697 Patent at Abstract. The release tab is subsequently detached, allowing the outer label to rotate about the container. The '269 patent describes methods by which the leading end of the outer label is "temporarily affixed to the container while the outer label is wrapped around the container. Once the trailing end is attached to a front surface of the leading end, the outer label can be rotated about the container over the inner label." '269 Patent at Abstract, 5:61-6:13. Both patents describe the outer label as preferably being adapted with a transparent portion or window permitting the viewing of information on the inner label and/or container. '697 Patent at Abstract; '269 Patent at Abstract.

Stephen Key Design and CCL Label (collectively, "Plaintiffs") assert that Lego Systems, Inc., The Lego Group, and Lego Schweiz AG (a.k.a. Lego Production AG) (collectively, "Defendants") infringe both—patents—by manufacturing, distributing, and-selling a product called "Lego Bionicle," which utilizes a labeling system that employs a fixed inner label, and an outer label that rotates about the inner label and container. See id., Exh. C.

### **LEGAL STANDARD**

[1][2] The construction of a patent claim is a matter of law for the Court. <u>Markman v. Westview Instruments, Inc.</u>, 517 U.S. 370, 372, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). To determine the meaning of a patent claim, the Court considers three sources: the claims, the specification, and the prosecution history. <u>Markman v. Westview Instruments, Inc.</u>, 52 F.3d 967, 979 (Fed.Cir.1995) (en banc), affd, <u>Markman</u>, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577.

[3] First, the Court looks at the words of the claims. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). "[T]he analytical focus must begin and remain centered on the language of the claims themselves, for it is that language \*1199 that the patentee chose to use to particularly point out and distinctly claim the subject matter which the patentee

regards as his invention." <u>Texas Digital Systems, Inc. v. Telegenix, Inc.</u>, 308 F.3d 1193, 1201-2 (Fed.Cir.2002)(internal quotations and citations omitted). Thus, there is a "heavy presumption" that claim terms bear their ordinary meaning, as understood by persons skilled in the relevant art. <u>Id. at 1202</u>; see also <u>Teleflex, Inc. v. Ficosa North America Corp.</u>, 299 F.3d 1313, 1325.

[4] Second, it is always necessary to review the specification to determine if the presumption of ordinary meaning is rebutted. Texas Digital Systems, 308 F.3d at 1204. The presumption is only rebutted in situations where the inventor (1) acting as his own lexicographer, clearly set forth an "explicit definition" of the term that is different from its ordinary meaning; or (2) has disavowed or disclaimed scope of coverage by using words of "manifest exclusion or restriction...." Id. "But if the meaning of the words themselves would not have been understood to persons of skill in the art to be limited only to the examples or embodiments described in the specification, reading the words in such a confined way would mandate the wrong result and would violate our proscription of not reading limitations from the specification into the claims." Id; see also Teleflex, 299 F.3d at 1326 ("limitations from the specification are not to be read into the claims...").

[5] Third, the court may consider the prosecution history of the patent, if in evidence. Vitronics, 90 F.3d at 1582. "Although the prosecution history can and should be used to understand the language used in the claims, it too cannot enlarge, diminish, or vary the limitations in the claims." Markman, 52 F.3d at 980 (internal quotations and citations omitted). However, a concession made or position taken to establish patentability in view of prior art, upon which the examiner has relied, is a substantive position on the technology for which a patent is sought, and will generally generate an estoppel. In contrast, when claim changes or arguments are made in order to more particularly point out the applicant's invention, the purpose is to impart precision, not to Such prosecution is not overcome prior art. presumed to raise an estoppel, but is reviewed on its facts, with the guidance of precedent. Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1220 (Fed.Cir.1995) (citations omitted).

[6][7][8][9] Ordinarily, the Court should not rely on expert testimony to assist in claim construction, because the public is entitled to rely on the public record of the patentee's claim (as contained in the

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patent claim, the specification, and the prosecution history) to ascertain the scope of the claimed invention. Vitronics, 90 F.3d at 1583. "[W]here the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper." Id. Extrinsic evidence should be used only if needed to assist in determining the meaning or scope of technical terms in the claims, and may not be used to vary or contradict the terms of the claims. <u>Id.</u> (quoting <u>Pall Corp.</u>, 66 F.3d at 1216); Markman, 52 F.3d at 981: However, the Court is free to consult reference materials, such as dictionaries, for assistance in determining the ordinary meaning of a claim term and such sources are not considered extrinsic evidence. Texas Digital Systems, 308 F:3d at 1202-03. Further, the intrinsic record must be consulted to determine which definition is most consistent with the use of the word by the inventor. Id. at 1203. However, "[i]f more than one dictionary definition is consistent with the use of the word[] in the intrinsic record, the claim term[ ] may be construed to encompass all such consistent meanings." Id.

\*1200 [10] The Court also has the discretion to admit and rely upon prior art proffered by one of the parties, whether or not cited in the specification or the file history, but only when the meaning of the disputed terms cannot be ascertained from a careful reading of the public record. Vitronics, 90 F.3d at 1584. Referring to prior art may make it unnecessary to rely on expert testimony, because prior art may be indicative of what those skilled in the art generally believe a certain term means. Id. Unlike expert testimony, these sources are accessible to the public prior to litigation to aid in determining the scope of an invention. Id.

[11] Finally, "[t]he subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim (except as documented in the prosecution history)." Markman, 52 F.3d at 985 (citation omitted). "Rather the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean." Id. at 986.

### ANALYSIS [FN2]

FN2. The parties withdraw the following terms from consideration: (1) "adhering a dot of glue"; (2) "applying a vacuum pressure"; (3) "applying a static electrostatic charge pressure"; (4) "applying an external

gaseous pressure"; and (5) "rotating the outer label relative to the inner label."

### A. "applying an external physical pressure"

[12] The term "applying an external physical pressure" appears only in the '269 patent, and Plaintiffs propose the following construction of the term: "The application of force to the label(s) and container by holding and pressing apparatus that arises or acts from the outside; i.e., separate and independent from the labels and container." Joint Claim Construction ("JCC") at 1:9-13.

Defendants object to the extent Plaintiffs' proposed construction "attempts to make a dependant claim (claim 5 of the '269 patent) broader than its referenced independent claim (claim 1 of the '269 patent)." [FN3] Defendants' Opposition to Brief Re: Claim Construction of the '269 and '697 Patents ("Opposition") at 3:5-12; see also <u>35 U.S.C.</u> § 112 ("a claim in dependant form shall be construed to incorporate by reference all the limitations of the claim to which it refers"). However, Defendants fail to offer--and the Court cannot find--any basis for determining that Plaintiffs' proposed construction would render claim 5 broader than claim 1. [FN4] Claim 5 is simply one of several dependant claims describing various methods of "temporarily coupling a leading end of an outer to the inner label while the outer label is wrapped about the object," as described in claim 1. See '269 Patent at Claims 2, 5-8. [FN5]

> FN3. Claim 1 of the '269 patent describes: "A method of applying a rotatable label to an object, comprising the steps of: [1] providing an object; [2] attaching an inner label with indicia disposed thereon about the object; [3] temporarily coupling a leading end of an outer label having indicia and a transparent portion thereon to the inner label while the outer label is wrapped about the object; [4] securing the outer label about the object; and [5] uncoupling the leading end of the outer label to permit the outer label to rotate about the inner label and the object." Claim 5 of the '269 states: "The method according to claim 1, wherein the step of temporarily coupling further comprises applying an external physical pressure to the outer label." Id.

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<u>FN4.</u> To the extent Defendants' argument is based on its proposed construction of the term "temporarily coupling," this argument is mooted by the Court's construction of that term. *See infra* Section C.

FN5. Defendants also object to Plaintiffs' proposed construction of the term "applying an external physical pressure" to the extent it affects the Court's construction of "temporarily coupling." It does not.

\*1201 Therefore, the Court adopts Plaintiff's proposed construction of "applying an external physical pressure"--"[t]he application of force to the label(s) and container by holding and pressing apparatus that arises or acts from the outside; i.e., separate and independent from the labels and container"--which is consistent with the relevant dictionary definition of "external." See Plaintiffs' Supporting Evidence, Exh. E (Merriam-Webster's Collegiate Dictionary, Tenth Edition) ("of, relating to, or connected with the outside or an outer part...applied or applicable to the outside"); see Texas Digital Systems, 308 F.3d at 1203 ("[d]ictionaries, encyclopedias and treatises, publicly available at the time the patent is issued, are objective -resources that-serve as-reliable-sources-of-informationon the established meanings that would have been attributed to the terms of the claims by those of skill in the art").

#### B. "temporarily coupling"

[13] The term "temporarily coupling" is used throughout both patents. [FN6] Merriam-Webster's Collegiate Dictionary defines "coupling" as "to fasten together." However, the parties' dispute more precisely relates to the definition of "temporarily." Plaintiffs contend that "temporarily coupling" means "[j]oiner, pairing, or bringing together to momentarily connect." JCC at 8:12-20 (emphasis added). On the other hand, Defendants argue that the "term requires a temporary physical securing, adhering, or affixing, not mere physical contact, between the leading end of the outer label and the inner label." Id. (emphasis added). However, the definition of "temporarily"--"lasting for a time only"--is broad enough to encompass both "momentary" contact as well as "physical securing, adhering, or affixing." See The Merriam Webster Dictionary, Home and Office Edition, 1995. Consequently, the term is not limited in the way Defendants suggest. In fact, based on this

definition, the only limitation on "temporarily" is that it not be permanent., *i.e.*, eventually allowing the outer label to rotate about the inner label and/or container.

FN6. The parties also dispute the terms "temporarily coupling an outer label to the inner label" and "temporary coupling to a leading end." However, the Court's construction of the term "temporarily coupling" will apply to these terms as well.

This definition is also consistent with the respective patent specifications. The '269 patent specification describes several methods of temporarily coupling the leading end of the outer label with the inner label, including (1) a blast of air or other gas; (2) moisture; (3) a holding or pressing apparatus; (4) vacuum pressure; or (5) a static electric charge. Id. at 5:61-6:13. [FN7] The '697 patent, on the other hand, describes a method by which "a release tab is removably attached to a rotatable label to facilitate attachment of the label to a container. The release tab is adhered to the container, or to a label affixed to the container, to secure the label to the container while the label is wrapped around the container. The release tab is then detached from the label once the label is wrapped about the container to permit the label to rotate about the container." Id. at 1:64-2:4.

FN7. The '269 patent specification also states that "[a] leading end is temporarily affixed to the container while the outer label is wrapped around the container." '269 patent at Abstract (emphasis added).

Therefore, the Court construes "temporarily coupling" to mean the following: to fasten together for a limited time, and, upon uncoupling, allowing the outer label \*1202 to rotate about the inner label and/or container.

### C. "temporarily adhering"

[14] The term "temporarily adhering" can be found in the '697 patent, and Plaintiffs propose the following construction of the term: "To temporarily hold fast or stick by or as if by gluing, suction, grasping, fusing or otherwise." JCC at 7:12-19. On the other hand, Defendants simply incorporate by reference their proposed construction of "temporarily

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coupling." Id. ("temporary physical securing, adhering, or affixing, not mere physical contact, between the leading end of the outer label and the inner label"). Although there seems to be no genuine dispute as to the meaning of the term "temporarily adhering," the Court adopts Plaintiffs' proposed construction of the term because it is consistent with the relevant definition contained in Merriam-Webster's Collegiate Dictionary ("to hold fast or stick by or as if by gluing, suction, grasping, or fusing").

### D. "uncoupling the leading end"

[15] The term "uncoupling the leading end" appears in the '269 patent, and Plaintiffs propose the following construction of the term: "To detach, disjoin or disconnect the temporary connection of the leading end." JCC at 15:9-13. Defendants object to Plaintiffs' proposed construction to the extent it is inconsistent with its proposed construction of "temporarily coupling." Finding no inconsistency, the Court adopts Plaintiffs' proposed construction of "uncoupling the leading end."

### E. Undisputed Terms

The meanings of the following terms are undisputed and will be adopted the Court for purposes of this action. [FN8]

<u>FN8.</u> Because the meanings of these terms have not been fully litigated, future litigants will not be not be bound these constructions.

- 1. "attaching an inner label" ('269 patent): "To make fast (as by gluing); fixedly joining the inner label to the container." JCC at 1:5-8; see Opposition at 4:1-10.
- 2. "attaching and securing" ('269 patent'): "Attaching the inner label and securing of the outer label" JCC at 3:5-9.
- 3. "between the top and bottom label panels" ('269 patent): "A recessed portion is provided thereby defining a top and bottom label panel at edges thereof. The recessed panel is between the top and bottom label panel." JCC at 3:9-15; see also March 5, 2003 Letter from Parties.
- 4. "detaching the outer label from the inner label" ('697 patent): "Rotating the outer label relative to the inner label to disengage the outer label from the inner label." JCC at 3:15-20; see also Opposition at 4:25-5:2.
- **5.** "detaching" ('697 patent): "To release or disengage" JCC 3:21-4:9

- 6. "feeding an inner label from the roll" ('269 patent): "To move inner labels from a roll into a machine or opening in order to be applied to the container." JCC at 4:9-13; see also Opposition at 5:4-6.
- 7. "feeding an outer label from a roll" ('269 patent): "To move outer labels from a roll into a machine or opening in order to be applied to the container." JCC at 4:13-18; see also Opposition at 5:4-6.
- 8. "holding the object stationary" ('269 patent): "Immobilizing the container or permitting it to remain \*1203 at rest." JCC at 4:18-5:4; see also Opposition 5:8-10.
- **9.** "providing an adhesive" ('269 patent): "To supply or make available an adhesive." JCC at 5:5-9; see also Opposition at 5:12-13.
- 10. "providing to and bottom label panels" ('269 patent): "A recessed portion is provided thereby defining a top and bottom label panel at the edges thereof." JCC at 5:9-14; see also March 5, 2003 Letter From Parties.
- 11. "roll-fed method" ('269 patent): "To move inner labels from a roll into a machine or opening in order to be applied to the container." JCC at 5:15-17; see also Opposition at 5:23-25.
- 12. "rolling the object" ('269 patent): "Rotating the container about an axis." JCC at 5:17-20; see also Opposition at 5:27-6:2.
- 13. "securing-the-outer-label-about-the-object" ('697 patent): "attaching the leading end of the outer label to the trailing edge of the outer label thereby forming a shape about the object." Opposition at 6:8-16.
- 14. "securing the outer label" ('269 patent): "attaching the leading end of the outer label to the trailing end so that a shape is formed outward of the inner label." Opposition at 6:18-23.
- 15. "securing" ('269 and '697 patents): "attaching the leading end of the outer label to the trailing end so that a shape is formed outward of the inner label." Opposition at 6:25-7:5.

### CONCLUSION

Based on the analysis above, the Court adopts the foregoing constructions of the disputed claim terms.

#### IT IS SO ORDERED.

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